



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,091	06/04/2001	Deborah Charych	1680.002	6042

7590

05/17/2002

Chiron Corporation
Intellectual Property Law Department
Mail Stop R-3
PO Box 8097
Emeryville, CA 94662

EXAMINER

TRAN, MY CHAU T

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 05/17/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,091

Applicant(s)

CHARYCH ET AL.

Examiner

My-Chau T. Tran

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16 and 53, drawn to an array of protein-binding agent with a peptidomimetic protein-binding segment, classified in class 422, subclass 61.
 - II. Claims 17-18, drawn to an array of protein-binding agent with a thiol substrate anchoring segment, classified in class 435, subclass 287.2.
 - III. Claims 19-20, drawn to an array of protein-binding agent with a biotin substrate anchoring segment, classified in class 422, subclass 50.
 - IV. Claim 54, drawn to a mixed array of protein-binding agent, classified in class 435, subclass 287.9.
 - V. Claims 21-36, drawn to a method of making an array with preparing a solid substrate for bonding, classified in class 435, subclass 7.1.
 - VI. Claims 37-42, drawn to a method of making an array with generating a library of protein binding agents, classified in class 436, subclass 528.
 - VII. Claims 43-52, drawn to a method for performing a differential binding assay, classified in class 435, subclass 7.93.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I, II, III and IV are unrelated and independent inventions.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together .

Art Unit: 1641

and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different required components. The feature of a linker segment connecting and separating the anchoring and peptidomimetic segment of Group I is not required by the claims of Groups II, III, and IV. The feature of a maleimide-functionalized aminothiols of Group II is not required by the claims of the Groups I, III, and IV. The feature of an orthogonal peptide linker segment of Group III is not required by the claims of Groups I, II, and IV. The feature of a plurality of different antibodies bound to the substrate of Group IV is not required by the claims of the other Groups I, II, and III.

3. Inventions of Groups V, VI, and VII are unrelated and independent inventions.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different required method step. The method step of contacting a plurality of different protein-binding agents with the substrate of Group V is not required by the claims of the Groups VI and VII. The method step of distributing protein-binding agents from the library into individual storage receptacles of Group VI is not required by the claims of the Groups V and VII. The method step of analyzing the array to determine differential binding of proteins of Group VII is not required by the claims of the Groups V and VI.

Art Unit: 1641

4. Inventions of Group I and Group V are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as “ink-jet” printing.

5. Inventions of Group II and Group V are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be used to practice another materially different process such as the method of Group VI.

6. Inventions of Group III and Group V are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as “ink-jet” printing.

Art Unit: 1641

7. Inventions of Group IV and Group V are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be used to practice another materially different process such as the method of Group VI.

8. Inventions of Group I and Group VI are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as mechanical deposition.

9. Inventions of Group II and Group VI are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as mechanical deposition.

Art Unit: 1641

10. Inventions of Group III and Group VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be used to practice another materially different process such as the method of Group V.

11. Inventions of Group IV and Group VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be used to practice another materially different process such as the method of Group V.

12. Inventions of Group I and Group VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as a direct non-competitive binding assay.

Art Unit: 1641

13. Inventions of Group II and Group VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed could be used in a materially different process such as a competitive binding assay.

14. Inventions Group III and Group VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as a direct non-competitive binding assay.

15. Inventions Group IV and Group VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed could be used in a materially different process such as a competitive binding assay.

Art Unit: 1641

16. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group II would involve a determination of the patentability of the combination of a composition comprised of a maleimide-functionalized aminothiols and a thiol substrate anchoring segment (independent of its use) while a patentability determination for Group III would involve a consideration of the patentability of the combination of an orthogonal peptide linker segment and a biotin substrate anchoring segment (independent of its use). These considerations are very different in nature.

17. Applicants are advised that in accordance with the court decisions in *In re Ochiai*, {71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995)} and *In re Brouwer* {77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996)}, in the event that a product claim is found to be allowable, a method of use claim *which is of the same scope as the allowed product claim* may be rejoined with the allowed product claim.

18. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

19. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1641

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

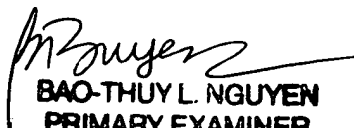
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

mct
May 17, 2002


BAO-THUY L. NGUYEN
PRIMARY EXAMINER
5/17/02 ✓